IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gregory Goodnight

Confirmation No.: 4235

Serial No.: 09/773,393 Examiner: Donald L. Mills

Filed: 1/31/2001 Group Art Unit: 2616

For: PACKET TELEPHONY ACROSS THE PUBLIC SWITCHED
TELEPHONE NETWORK

Date: February 28, 2008

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANTS' BRIEF UNDER 37 C.F.R. § 41.37

Appeal is taken from the Examiner's Final Office Action mailed September 13, 2007,

finally rejecting claims 2231 in this application.

This Appeal Brief is in furtherance of the Notice of Appeal in this case filed on

November 15, 2007.

The fees required under § 41.20(b)(2) are dealt with in the accompanying

TRANSMITTAL OF APPEAL BRIEF.

A single copy of this brief is submitted in accordance with 37 C.F.R. § 41.37(a)(1).

This Brief contains these items under the following headings, and in the order set forth

below:

TABLE OF CONTENTS

I.   REAL PARTY IN INTEREST - 37 C.F.R. § 41.37(c)(1)(i)

Gregory Goodnight and Cisco Technology, Inc. are the real parties in interest.

II.   RELATED APPEALS AND INTERFERENCES - 37 C.F.R. § 41.37(c)(1)(ii)

There are no other appeals or interferences known to Applicant, the Applicant's representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III.   STATUS OF CLAIMS - 37 C.F.R. § 41.37(c)(1)(iii)

Status of All the Claims:

1.   Claims presented: 1-31

2.   Claims withdrawn from consideration but not canceled: None

3.   Claims canceled: 1-21

4.   Claims pending: 22-31, of which:

    a.   Claims allowed: NONE

    b.   Claims rejected: 22-31

All the rejected claims, namely claims 22-31, are being appealed. The appealed claims are eligible for appeal, having been finally rejected.

IV.   STATUS OF AMENDMENTS - 37 C.F.R. § 41.37(c)(1)(iv)

There have been no amendments filed subsequent to the Final Office Action dated September 13, 2007.

V.   SUMMARY OF THE CLAIMED SUBJECT MATTER - 37 C.F.R. § 41.37(c)(1)(v)

Claim 22 requires, "a converter to receive a packet data stream intended for a packet domain..." see page 3, and Figure 2, converter 24. The converter is to convert the packet data stream into an altered data stream intended for transmission through a public switched telephone network, discussed at page 3, lines 13-19. Claim 22 also requires a controller, see Figure 3, controller 32 and page 4. The controller is to establish a connection through the public switched telephone network with at least one other network device using the altered data stream. See page 6, line 29 through page 7, lines 5, box 42 of Figure 4. The controller send signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data, see box 44 of Figure 4. The controller determines, using signals received from one of the other network devices, whether the other network device is a packet device that can receive packet data, see the text referenced above and Figure 4. The controller sends the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data, see page 7, lines 6-10 and Figure 4, box 46. The controller then sends the altered data stream to the other network device, if the

network device determines that the other network device is not a packet device and cannot receive packet data. This is shown as the using the converter in Figure 2.

Claim 27 requires receiving a packet data stream intended for a packet domain and converting the packet data stream into a altered data stream intended for transmission through a public switched telephone network, at page 6, lines 29-34, Figure 4; establishing a connection through the public switched telephone network with at least one other network device using the altered data stream, page 6, lines 29-34 and Figure 4; sending signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data, page 7, lines 1-5, Figure 4; determining, using signals received from the other network device, whether the other network device is a packet device that can receive packet data, page 7, lines 1-15, Figure 4; sending the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data, page 7, lines 6-10 and Figure 4; and sending the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data, shown as Figure 2 and the option if the other device is not a packet device discussed on page 7.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
37 C.F.R. § 41.37(c)(1)(vi)

Claims 22-31 have been rejected under 35 USC 102(a) as being anticipated by "Series V: Data Communications over the Telephone Network," ITU-T V.8 bis, 1999 ('1999 ITU Recommendation').

VII. ARGUMENT - 37 C.F.R. § 41.37(c)(1)(vii)

A. Grouping of Claims

For purposes of the rejections under 35 USC 102(a), claims 22-31 are grouped together.

B. General Comments on ITU-V.8 *bis* (1999)

The ITU-Recommendation V.8 *bis* (1999) was cited in the second final office action, mailed September 13, 2007. The previous office action, mailed June 29, 2007 had cited a new version of this recommendation, approved in November 2000, but not published until September 2001. As this patent application was filed in January 2001, this was not a valid reference. One aspect of the claimed subject matter concerns the changes between the two recommendations, as such, the claimed subject matter is not shown in the previous version of the recommendation, the 1999 version that is now being cited as a reference.

There is a detailed discussion as to the contents and teachings of the 1999 ITU Recommendation and the aspects of the claimed invention that are not contained therein on pages 5 and 6. It is possible that the Examiner has misinterpreted the Appellant's comments with regard to the extensibility of the 1999 ITU Recommendation to find that the extensions are contained in the recommendation, when those extensions are actually implemented as the Appellant's invention as claimed.

C. Arguments

Claims 22-31 are patentable and not anticipated by ITU Recommendation V.8 *bis* 1999.

In so far as claims 22-31 have been rejected under the same grounds, Appellant argues them as a group.

The office action mailed September 13, 2007 relies upon International Telecommunications Union Recommendation V.bis (1999) as prior art. The Applicant's

Specification (p. 6) discusses this recommendation at length and points out significant areas that are not contained in the 1999 ITU Recommendation.

The office action states, "V.8 bis allows the multifunction terminals to allow a desired communication mode...and provides user friendly switching from *normal voice telephony to a modem-based communications mode* [emphasis added]." (p. 3). Further, on page 5, the office action refers to the multifunction terminals as 'modems.'

The instant invention is not directed to modem communications across the PSTN, the instant invention is related to Packet Relay Across Telephone (PRAT). As claimed in claim 22, the device, a packet device, has a converter that receives "*a packet data stream intended for a packet domain and [to] convert[s] the packet data stream into an altered data stream intended for transmission through a public switched telephone network...*" The altered data stream is the data stream that has been operated on by the converter. As stated in the Applicants' specification, one example of a converter is a modem (p. 3, line 19).

The 1999 ITU Recommendation refers to switching between voice (standard PSTN) calls and data (modem) calls. The voice calls are standard PSTN signaling and are not packet data streams. The 1999 ITU Recommendation states, in Appendix 1, "With the growth in availability of multifunction terminals and multimedia applications, it is anticipated that users with increasingly require:...a convenient way of switching between normal voice telephony and modem-based communications."

Further, if the call switches to a modem call, it employs the converter (modem) to convert the data to modem tones for transmission across the PSTN. This would be analogous to sending *an altered data stream.*

Claim 22 clearly requires that, if the other device is also a *packet* device (not a modem), the *packet data stream* (unaltered) is sent to the other device. The device of the claim also has the capability to use the converter (modem) if the other device is *not* a packet device to send the *altered* (packet to PSTN modem stream) to the other device. However, the claim requires that the controller *send the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data.* This is not shown or taught by the 1999 ITU Recommendation.

Claims 23-26 depend from claim 22. The 1999 ITU Recommendation does not teach the requirements of claim 22, much less the further features of claims 23-26. With regard to claim 23, the 1999 ITU Recommendation does not teach a network device that is capable of sending an unaltered data stream to another packet device, where that network device is a voice gateway.

With regard to claim 24, the 1999 ITU Recommendation does not teach a network device capable of sending an unaltered packet data stream to another packet device across the PSTN, where the packet data stream is coded voice or data.

With regard to claim 25, the 1999 ITU Recommendation does not teach a network device that has a converter that may be avoided, much less that the converter is a voice coder/decoder, nor does it teach that the converter being a modem and that the modem is avoidable.

With regard to claim 26, the 1999 ITU Recommendation does not teach a network device that has a controller that can send packet data without using a converter, much less a controller that uses either ITU V.8 protocols or robbed-bit signaling to identify the network device as a packet device.

Claim 27 requires determining, using signals received from the other network device, whether the other network device is a packet device that can receive packet data; and *sending the*

packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data. For the reasons as discussed with regard to claim 22, the 1999 ITU Recommendation does not show or teach this.

With regard to claim 28, for the reasons as discussed with regard to claims 26, this is not shown or taught by the reference.

With regard to claim 29, the reference does not show or teach this for the reasons as applied to claim 25.

With regard to claim 30, the reference does not show or teach storing information on the other network device and storing the information for further use. The office action states, "V.8 bis permits each terminal the capability to *exchange a list of communication modes and then automatically selects the corresponding mode...* There is no mention in this language of storing anything with regard to the exchanged capabilities. Further, since the selection is made automatically, there would not appear to be any reason to store the information.

With regard to claim 31, this reference does not show or teach this, for the reasons as applied to claim 30. Because the capabilities are exchanged, there is not indication that there is a need to store the capabilities at that time, much less for later use in determining if the device is a packet device.

For these reasons, Appellant submits that claims 22-31 are patentably distinguishable over the prior art and allowance of these claims is requested.
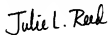
CONCLUSION

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's 35 U.S.C. § 102(a) rejections of Appellant's claims.

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Respectfully submitted,

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CLAIMS APPENDIX - 37 C.F.R. § 41.37(c)(viii)

The text of claims 22-31 on appeal is as follows:

1. – 21. (canceled)

22.   (previously presented)   A network device, comprising:

a converter to receive a packet data stream intended for a packet domain and to convert the packet data stream into an altered data stream intended for transmission through a public switched telephone network; and

a controller to:

establish a connection through the public switched telephone network with at least one other network device using the altered data stream;

send signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data;

determine, using signals received from one of the other network devices, whether the other network device is a packet device that can receive packet data;

send the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data; and

send the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data.

23.   (previously presented)   The network device of claim 1, wherein the network device comprises a voice gateway.

24.   (previously presented)   The network device of claim 1, wherein the packet data stream comprises one of either coded voice or data.

25.   (previously presented)   The network device of claim 1, wherein the converter comprises one of either a voice coder/decoder or a modem.

26.   (previously presented)   The network device of claim 1, wherein the controller employs one of either ITU V.8 protocols, or robbed-bit signaling to identify the network device as a packet device.

27.   (previously presented)   A method, comprising:

    receiving a packet data stream intended for a packet domain;

    converting the packet data stream into an altered data stream intended for transmission through a public switched telephone network;

    establishing a connection through the public switched telephone network with at least one other network device using the altered data stream;

    sending signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data;

    determining, using signals received from the other network device, whether the other network device is a packet device that can receive packet data;

    sending the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data; and

    sending the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data.

28.   (previously presented)   The method of claim 27, wherein sending signals comprises sending signals in accordance with ITU Recommendation V.8.

29.   (previously presented)   The method of claim 27, wherein converting the packet data stream further comprises using one of either a voice coder/decoder or a modem to convert the packet data stream to the altered data stream.

30.   (previously presented)   The method of claim 27, comprising gathering information on the other network device and storing the information for further use.

31.   (previously presented)   The method of claim 27, wherein determining comprises:

    accessing a storage of known network devices based upon the signals received from the other device;

    locating information about the other network device; and

    using that information in determining whether the other device is a packet device.

EVIDENCE APPENDIX - 37 C.F.R. § 41.37(c)(ix)

NONE

RELATED PROCEEDINGS APPENDIX

37 C.F.R. § 41.37(c)(x)

NONE